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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/885,900
Filing Date: June 20, 2001
Appellant(s): BAGGS, SCOTT

Daniel R. McClure
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 9, 2007 appealing from the Office action mailed September 27, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,433,941	ONODA	8-2002
6,331,886	NAGANO et al.	12-2001

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JP 2000-209408

MINOWA

3-2002

6,408,161

MINOWA

6-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 8, 16, 17, 26, 32, 40-43, 55, 56, 59, 64, 70, and 75 are rejected under 35

U.S.C. 102(e) as being anticipated by Onoda US Patent No. 6,433,941.

Regarding Claim 1, Onoda teaches (see Fig. 2B, 3, 6, 7, 8) a space-saving scanner assembly, comprising a housing (30) having a substantially vertical source-contact surface (10) with a member (21) forming a channel (along (21a) bounded by (21a), (24), and (10)) that protrudes from the housing (see Fig. 2B), said member having a first side (24) that is substantially parallel to, and opposed from, said source-contact surface, said member having a second side (21a) substantially orthogonal to the first side (see Fig. 2B), wherein the member extends to an exterior surface of said housing (see Fig. 2B), and a flap (40) coupled to the source-contact surface (see Fig. 3 and 6), the flap having a source-backing surface (facing (10)) substantially parallel to the source-contact surface of the housing (See Fig. 4), wherein the source-contact surface, the source-backing surface, and the first and second sides of the member

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form an aperture (gap bounded by (40), (10), and (21)- see Fig. 6) for receiving an edge (edge of (P) contacting (21a) in Fig. 2B) of a source (P) to be scanned (see Fig. 2B).

Regarding Claim 2, Onoda teaches a portion of the vertical source-contact surface of the housing comprises a platen (10) to permit scanning of a source document in a vertical position (see Fig. 2B and 3).

Regarding Claim 8, Onoda teaches the platen having an upper edge (top edge in orientation in Fig. 8), an opposing lower edge (bottom edge in orientation in Fig. 8), a front edge (forward edge in orientation in Fig. 8) relatively coexistent with a front panel of the housing and a distal edge (rear edge in orientation in Fig. 8) and wherein said member is adjacent to the lower edge of the platen (see orientation of Fig. 2B, 3, 6, and 8).

Regarding Claim 16, Onoda teaches (see Fig. 2B, 3, 6, 7, 8) a space-saving scanner assembly, comprising means (30) for housing an optical scanning means (U) (see Fig. 7), and means (21, 40, 10) for forming an aperture (between (21a), (40), and (10)- see Fig. 2B and Fig. 6) configured to closely receive a leading edge (vertical edge) (see Fig. 2B) of a source (P), such that the source can be spatially arranged with the optical scanning means without adjusting the aperture (since there is a gap between the flap (40) and the platen (10) as seen in Fig. 6, and since the flap opens in the horizontal direction from the front of the scanner when vertically oriented (see Fig. 3) and therefore the gap is accessible from the front side of the scanner without any movement of the flap or housing for horizontal insertion of the source), the source being supported along a horizontal edge (edge of (P) contacting (21a) in Fig. 2B) different from the leading edge of said source along a channel means (21a) (see Fig. 2B).

Regarding Claim 17, Onoda teaches a source retaining means (24) (see Fig. 2B) of said channel means extends vertically from a base (21a) of said channel.

Regarding Claim 26, Onoda teaches (see Fig. 2B, 3, 6, 7, 8) a space-saving scanner assembly, comprising a housing (30) having a substantially vertical source-contact surface (10), a member (21) forming a channel (along (21a) bounded by (21a), (24), and (10)) protruding from the housing (see Fig. 2B), and a flap (40) coupled to the housing (see Fig. 3 and 6), the flap having a source-backing surface (facing (10)) substantially parallel to the source-contact surface of the housing, wherein the source-contact surface, the source-backing surface, and the member form an aperture (gap bounded by (40), (10), and (21)- see Fig. 6) for horizontally receiving a source to be scanned without necessitating relative movement between the flap and the housing (since there is a gap between the flap (40) and the platen (10) as seen in Fig. 6, and since the flap opens in the horizontal direction from the front of the scanner when vertically oriented (see Fig. 3) and therefore the gap is accessible from the front side of the scanner without any movement of the flap or housing for horizontal insertion of the source).

Regarding Claim 32, Onoda teaches (see Fig. 3 and 6) the member having a first end proximal to a front panel (front plane shown in Fig. 6) and a distal end that extends at least to a distal edge of a platen (see Col. 6, lines 1-6).

Regarding Claim 40, Onoda teaches (see Fig. 2B, 3, 6, 7, 8) a space-saving scanner assembly, comprising a housing (30) having a substantially vertical source-contact surface (10), a flap (40) coupled to the source-contact surface (see Fig. 3 and 6), the flap having a source-backing surface (facing (10)) substantially parallel to the source-contact surface of the housing (see Fig. 6); and a support member (21) interposed between said housing and said flap and

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extending to a front panel of the housing (see Fig. 3 and 6), wherein the source-contact surface, the source-backing surface, and said support member form an aperture (gap bounded by (40), (10), and (21)- see Fig. 6) for horizontally receiving a source to be scanned without necessitating relative movement between the flap and the housing (since there is a gap between the flap (40) and the platen (10) as seen in Fig. 6, and since the flap opens in the horizontal direction from the front of the scanner when vertically oriented (see Fig. 3) and therefore the gap is accessible from the front side of the scanner without any movement of the flap or housing for horizontal insertion of the source).

Regarding Claim 41, Onoda teaches a portion of the vertical source-contact surface of the housing comprises a platen (10) to permit scanning of a source document in a vertical position (see Fig. 2B and 3).

Regarding Claim 42, Onoda teaches the platen having an upper edge (top edge in orientation in Fig. 8), an opposing lower edge (bottom edge in orientation in Fig. 8), a front edge (forward edge in orientation in Fig. 8) relatively coexistent with a front panel of the housing and a distal edge (rear edge in orientation in Fig. 8) and wherein said support track member is adjacent to the lower edge of the platen (see orientation of Fig. 2B, 3, 6, and 8).

Regarding Claim 43, Onoda teaches (see Fig. 3 and 6) the member having a distal end that extends at least to the distal edge of a platen (see Col. 6, lines 1-6).

Regarding Claim 55, Onoda teaches (see Fig. 2B, 3, 6, 7, 8) a space-saving scanner assembly, comprising means (30) for housing an optical scanning means (U) (see Fig. 7), and means (21, 40, 10) for forming an aperture (between (21a), (40), and (10)- see Fig. 2B and Fig. 6) configured to closely receive a leading edge (vertical edge) (see Fig. 2B) of a source (P)

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transferred horizontally along a plane substantially orthogonal to a front surface of the means for housing (since there is a gap between the flap (40) and the platen (10) as seen in Fig. 6, and since the flap opens in the horizontal direction from the front of the scanner when vertically oriented (see Fig. 3) and therefore the gap is accessible from the front side of the scanner without any movement of the flap or housing for horizontal insertion of the source), such that the source can be spatially arranged with the optical scanning means without adjusting the aperture (since there is a gap between the flap (40) and the platen (10) as seen in Fig. 6), the source being supported along a second edge (edge of (P) contacting (21a) in Fig. 2B) of said source by a support means (21) in the aperture, said support means extending to a front panel of the means for housing (see Fig. 3 and 6), wherein said support means is interposed between a first source-retaining means and said optical scanning means (see Fig. 6).

Regarding Claim 56, Onoda teaches the support means comprising a second source retaining means (24) (see Fig. 2B) substantially parallel to the optical scanning means (see Fig. 3 and 7).

Regarding Claim 59, Onoda teaches (see Fig. 2B, 3, 6, 7, 8) a method for saving space on a desktop, comprising providing an optical scanner (U) (see Fig. 7) within a housing (30), the housing having a substantially vertical source-contact surface (10) (see Fig. 8) with a support member (21) protruding from the housing, the support member extending to the exterior of the housing (see Fig. 2B), and providing a flap (40) closely coupled to the source-contact surface (see Fig. 6), the flap, support member, and source-contact surface forming an aperture (between (21a), (40), and (10)- see Fig. 2B and Fig. 6) for receiving a source moved horizontally to be scanned (since there is a gap between the flap (40) and the platen (10) as seen in Fig. 6, and since

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the flap opens in the horizontal direction from the front of the scanner when vertically oriented (see Fig. 3) and therefore the gap is accessible from the front side of the scanner without any movement of the flap or housing for horizontal insertion of the source).

Regarding Claim 64, Onoda teaches (see Fig. 2B, 3, 6, 7, 8) a space-saving scanner assembly, comprising a housing (3) having a substantially vertical source-contact surface (10) comprising a platen (10), a flap (40) coupled to the housing (see Fig. 3 and 6), the flap having a source-backing surface (facing (10)- see Fig. 6) substantially parallel to the source-contact surface of the housing (see Fig. 6), and a support member (21) interposed between the source-contact surface and the source-backing surface proximal to a perimeter segment of the platen (see Fig. 6 and Col. 5, lines 1-6), wherein the source-contact surface, the source-backing surface, and the support member form an aperture (between (21a), (40), and (10)- see Fig. 2B and Fig. 6) for receiving a first edge (vertical edge) (see Fig. 2B) of a source (P) moved horizontally without necessitating relative movement between the flap and the housing (since there is a gap between the flap (40) and the platen (10) as seen in Fig. 6, and since the flap opens in the horizontal direction from the front of the scanner when vertically oriented (see Fig. 3) and therefore the gap is accessible from the front side of the scanner without any movement of the flap or housing for horizontal insertion of the source) to align a second edge (bottom) of the source with the perimeter segment of the platen (see Fig. 2B).

Regarding Claim 70, Onoda teaches (see Fig. 3 and 6) the member having a first end proximal to a front panel (front plane shown in Fig. 6) and a distal end that extends at least to a distal edge of a platen (see Col. 6, lines 1-6).

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Regarding Claim 75, Onoda teaches (see Fig. 2B, 3, 6, 7, 8) a method for arranging a source in a scanner comprising horizontally inserting (since there is a gap between the flap (40) and the platen (10) as seen in Fig. 6, and since the flap opens in the horizontal direction from the front of the scanner when vertically oriented (see Fig. 3) and therefore the gap is accessible from the front side of the scanner without any movement of the flap or housing for horizontal insertion of the source) a leading edge (vertical edge) of the source (P) into an aperture (between (21a), (40), and (10)- see Fig. 2B and Fig. 6) formed by a support member (21) interposed between a platen (10) and a flap (40) (see Fig. 3 and 6) such that a surface (facing (10)) of the source having information thereon that is desired to be imaged by the scanner is adjacent to a sensor (U) (see Fig. 7) arranged in a substantially vertical plane (see Fig. 7 and 8), and adjusting the source (see Col. 5, lines 4-6) such that the information desired to be imaged is aligned with the sensor (since the support member is parallel with the length of the scanner).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 9, 15, 19, 27, 45, 58, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onoda in view of Nagano et al. US Patent No. 6,331,886.

Regarding Claims 3, 9, 19, 27, 45, 58, and 65, Onoda teaches the device and method in the parent claims, according to the above rejection. Regarding Claim 9, Onoda teaches (see Fig. 3 and 6) the member having a first end proximal to a front panel (front plane shown in Fig. 6)

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and a distal end that extends at least to an edge of a platen (see Col. 6, lines 1-6). Onoda does not teach a front panel of the housing comprising an inclined surface adjacent to the aperture, the inclined surface forming a wider opening at the surface of the front panel. Regarding Claim 58, Onoda also does not teach a second inclined surface associated with the first source retaining means. Nagano et al. teach (see Fig. 13 and 14) a similar device and method with a vertical scanner and horizontally receiving a source (into (203a)) into an aperture (203a), with a front panel (202) of a housing (201) comprising a first inclined surface (left inclined portion of (203) next to (203a)) adjacent to the aperture, the inclined surface forming a wider opening for the aperture at the surface of the front panel (see Fig. 13), with a second inclined surface (right inclined portion of (203) next to (203a)) associated with the first source retaining means. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a front panel of the housing comprising a first inclined surface adjacent to the aperture with the inclined surface forming a wider opening for the aperture at the surface of the front panel, and provide the second inclined surface, as taught by Nagano et al. in the device and method of Onoda, to provide easier insertion and removal of sources into the scanner. Since the aperture of Onoda is bounded by the housing on one side and the flap on the other, modifying the device of Onoda with the teachings of Nagano would provide one inclined surface on the housing and the other inclined surface on the flap.

Regarding Claim 15, Onoda in view of Nagano et al. teach the device in the parent claim, according to the above rejection. Onoda does not teach said member coated with a material having a relatively low coefficient of friction. It is well known in the art to use materials with relatively low coefficient of friction to facilitate the insertion and removal of objects into slots-

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for example, floppy disk drives and paper feeders for printers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the member with a material having a relatively low coefficient of friction, in the device of Onoda in view of Nagano et al., to provide easier movement of documents for insertion and removal from the apparatus.

Claims 4, 28, 46, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onoda in view of Minowa JP2000-209408 (hereinafter Minowa '408).

Regarding Claims 4, 28, 46, and 66, Onoda teaches the device and method in the parent claims, according to the above rejection. Onoda does not teach the flap comprising an inclined surface adjacent to the aperture. Minowa '408 teaches (see Fig. 4) a similar device and method with a housing (11), an aperture (S), and a flap (14), wherein the flap comprises an inclined surface (adjacent to (14b)) adjacent to the aperture (see Fig. 4), the inclined surface arranged such that the aperture is larger adjacent to a front edge (top edge of (14) in Fig. 4) of the flap, wherein the front edge is substantially perpendicular to the source backing surface (see Fig. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the flap with an inclined surface adjacent to the aperture, the inclined surface arranged such that the aperture is larger adjacent to a front edge of the flap, wherein the front edge is substantially perpendicular to the source backing surface, as taught by Minowa '408 in the device and method of Onoda, to facilitate the insertion and removal of the source.

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1. Claims 5, 6, 10-12, 18, 20, 29, 30, 33, 47-51, 57, 67, 68, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onoda in view of Minowa US Patent No. 6,408,161 (hereinafter Minowa '161).

Regarding Claims 5, 12, 18, 29, 30, 47, 48, 57, 67, and 68, Onoda teaches the device and method in the parent claims, according to the above rejection. Onoda does not teach the flap comprising a slot, wherein the slot is positioned to permit the placement of a relatively short source document on edge on the member such that information to be scanned is aligned with at least a portion of the platen. Minowa '161 teaches (see Fig. 8 and 10) a similar device and method, with a housing (111), a support member (138b), and a flap (130), wherein the flap comprises a slot (in (139)), wherein the slot is positioned to permit the placement of a relatively short source document on edge on the member (see Col. 8, lines 56-58) such that information to be scanned is aligned with at least a portion of the platen (see Col. 8, lines 61-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the flap comprising a slot, wherein the slot is positioned to permit the placement of a relatively short source document on edge on the member such that information to be scanned is aligned with at least a portion of the platen, as taught by Minowa '161 in the device and method of Onoda, to provide additional access to the scanning area without excessive component movement, for increased convenience.

Regarding Claims 6 and 51, Onoda teaches the device and method in the parent claims, according to the above rejection. Onoda does not teach the source-backing surface of the flap comprising a clip arranged to receive a portion of a source document to be scanned. Minowa '161 teaches (see Fig. 8 and 10) a similar device and method, with a housing (111), a support

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member (138b), and a flap (130), wherein the source-backing surface of the flap comprises a clip (138) arranged to receive a portion of a source document to be scanned. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the source-backing surface of the flap with a clip arranged to receive a portion of a source document to be scanned, as taught by Minowa '161 in the device and method of Onoda, to secure the document during scanning for accurate scanning results.

Regarding Claims 10, 11, 33, 49, 50, and 71, Onoda teaches the device and method in the parent claims, according to the above rejection. Onoda does not teach the flap coupled to the housing with at least one post assembly having a plurality of spatially separated detent positions. Minowa '161 teaches (see Fig. 8 and 10) a similar device and method, with a housing (111), a source-contact surface (112), a support member (138b), and a flap (130) with a source-backing surface (facing (112)), wherein the flap is coupled (see Fig. 14) to the housing with at least one post assembly (240) having a plurality (front and back) of spatially separated detent positions and the flap is coupled to the housing with at least one adjustable fastener (139a) for closely contacting the source-backing surface to the vertical source-contact surface (see Col. 8, lines 21-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a post assembly with a plurality of separated detent positions and a flap with an adjustable fastener as taught by Minowa '161 in the device and method of Onoda, to provide easy operation of the flap and prevent the flap from opening during operation of the scanner.

Regarding Claim 20, Onoda teaches the device in Claim 1, according to the above paragraphs. Onoda also teaches horizontally receiving a source to be scanned (since there is a gap between the flap (40) and the platen (10) as seen in Fig. 6, and since the flap opens in the

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horizontal direction from the front of the scanner when vertically oriented (see Fig. 3) and therefore the gap is accessible from the front side of the scanner without any movement of the flap or housing for horizontal insertion of the source). Onoda does not teach a slot extending to an edge of the flap. Minowa '161 teaches (see Fig. 8 and 10) a similar device and method, with a housing (111), a support member (138b), and a flap (130), wherein the flap comprises a slot (in (139) extending to an edge (plane edge of (130) contacting (112)) of the flap. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a slot in the flap extending to an edge of the flap, as taught by Minowa '161 in the device and method of Onoda, to provide additional access to the scanning area without excessive component movement, for increased convenience.

Claims 7, 13, 31, 34, 36, 52-54, 69, 72, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onoda.

Regarding Claims 7, 13, 31, 34, 52, 53, 69, and 72, Onoda teaches the device and method in the parent claims, according to the above rejection. Regarding Claim 52, Onoda teaches (see Fig. 2B) a second member (43) of the support member. Onoda does not teach a recess configured to receive a portion of the member when an operator closely adjusts the source contact surface to the substantially vertical surface of the housing, or the housing configured to extend the member away from the vertical source-contact surface when an operator adjusts the source backing surface in relation to the vertical source-contact surface of the housing to increase the width of the aperture. It is well known in the art to provide recessed and elongated areas for components in a system, to retract or extend the components according to a desired adjustment.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a recess configured to receive a portion of the member when an operator closely adjusts the source contact surface to the substantially vertical surface of the housing, or the housing configured to extend the member away from the vertical source-contact surface when an operator adjusts the source backing surface in relation to the vertical source-contact surface of the housing to increase the width of the aperture, in the device and method of Onoda, as it has been held that the provision of adjustability, where needed, involves only routine skill in the art. In re Stevens, 101 USPQ 284 (CCPA 1954).

Regarding Claims 36, 54, and 74, Onoda teaches the device and method in the parent claims, according to the above rejection. Onoda does not teach said member coated with a material having a relatively low coefficient of friction. It is well known in the art to use materials with relatively low coefficient of friction to facilitate the insertion and removal of objects into slots- for example, floppy disk drives and paper feeders for printers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the member with a material having a relatively low coefficient of friction, in the device and method of Onoda, to provide easier movement of documents for insertion and removal from the apparatus.

Claims 21-25 and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onoda (in view of Minowa '161 for Claims 21-25), further in view of Minowa '408.

Regarding Claims 21-25 and 60-63, Onoda (and Minowa '161 for Claims 21-25) teach the method in Claims 20 and 59, according to the above paragraphs. Regarding Claim 21,

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Onoda teaches a horizontal edge of the source different from the leading edge is supported along the member (since there is a gap between the flap (40) and the platen (10) as seen in Fig. 6, and since the flap opens in the horizontal direction from the front of the scanner when vertically oriented (see Fig. 3) and therefore the gap is accessible from the front side of the scanner for horizontal insertion of the source). Regarding Claim 22, Onoda teaches spatially arranging the flap and the housing wherein pressure is applied to a non-scan surface (facing the flap) of the source and the scan surface of the source closely contacts the transparent platen portion (see Fig. 2B). Regarding Claims 23 and 63, Onoda teaches enabling the optical scanner to scan the source (see Col. 1, lines 43-45). Regarding Claim 24, Onoda teaches spatially arranging the flap and the housing wherein pressure is removed from the non-scan surface of the source (if the user decides to remove the source by opening the flap as seen in Fig. 3). Regarding Claims 25 and 63, a source is inherently removed from the aperture, as an operator retrieves and keeps the source once the scanning is completed. Onoda does not teach inserting a leading edge of a source to be scanned into the aperture, with inserting accomplished absent relative movement between the flap and the housing. Minowa '408 teaches (see Fig. 4) a similar device and method, with inserting a leading edge of a source (see Fig. 4) to be scanned into an aperture (S), with inserting accomplished absent relative movement between the flap and the housing (see Fig. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to insert a leading edge of a source to be scanned into the aperture, with inserting accomplished absent relative movement between the flap and the housing, as taught by Minowa '408, in the method of Onoda (in view of Minowa '161 for Claims 21-25), to provide easier insertion and removal of the source and to reduce the repetitive motions of components of the device for increased durability.

(10) Response to Argument

Regarding Appellant's arguments directed towards Claim 1, Appellant argues that the Examiner has mixed and matched components from FIGs. 2B and 3 (an embodiment of the invention of Onoda with the different invention of FIG. 6, which is designated as "prior art" to the invention of Onoda. Examiner asserts that Onoda discloses in Col. 4, lines 14-19 with respect to an embodiment of the invention of Onoda:

The whole of the image scanner 50 (image reading apparatus) has been described with respect to the prior art and therefore, herein the same reference characters are given and the description thereof is omitted, and portions of the present invention will be described in detail.

Thus, as seen in the rejection, it is evident that Examiner utilized Fig. 6 to describe the details of the flap 40 in relation to the channel, since Fig. 6 provides an enlarged view of the relationship between the flap 40 and components 10 and 21. Since the scanner configuration of the invention of Onoda is identical with respect to the prior art embodiment of Onoda with the exception of the details disclosed in Figs. 1-3, Examiner asserts that the usage of Fig. 6 to clarify a configuration which is applied to the inventive embodiment of Onoda is proper.

Appellant further argues with respect to Claim 1, in the Appeal Brief, Page 7, last paragraph, that:

... as is clear from the zoomed portion of the illustration in FIG. 6, the edge 21a is NOT substantially orthogonal to any other edge of that element. Instead, the edge 21a is disposed at an oblique angle (which appears to be an angle of approximately 45°) to the other edges of that element.

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As seen in the Examiner's rejection of Claim 1, Fig. 6 was cited to demonstrate the relationship between the flap 40, element 10 and element 21 to illustrate the claimed aperture, whereas **Fig. 2B** was cited to disclose the member having a second side 21a substantially orthogonal to the first side 24. As seen in Fig. 2A and 2B, multiple embodiments of element 21 are disclosed, but the relationship between flap 40, element 21, and element 10 remains the same as the enlarged view shown in Fig. 6. Thus, the Examiner submits that Fig. 2B discloses the edge 21a substantially orthogonal to the side 24a.

Regarding Appellant's arguments directed towards Claim 3, Appellant argues that Nagano does not teach an inclined surface but instead, "the sides of 203 are stepped and not inclined" (Page 9, last paragraph). Examiner asserts that the surface 203 contains an inclined portion shown in Fig. 13, where a curved portion is indented into the apparatus with respect to the vertical plane. As seen in Fig. 14, the curved portion allows the end of the inserted media to be exposed for easy removal by an operator's fingers. Even by Appellant's cited definition of "inclined" as "having a leaning or slope", the curved portion of 203 provides a sloped region curved inward into the apparatus.

Appellant also argues for Claim 3 in the Appeal Brief, Page 13, 1st paragraph, that the "alleged motivation embodies clear hindsight reasoning, as the reason advanced by the Examiner is based on a perceived beneficial, after-the-fact result". Examiner asserts that both references involve the insertion and removal of scanning media from an optical scanner and thus, incorporating the features of one device into another would have been obvious to one of ordinary skill in the art. Further, it must be recognized that any judgment on obviousness is in a sense

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necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant also argues for Claim 15 in the Appeal Brief, Page 14, 1st paragraph, that the combination of Nagano with the Onoda reference "embodies improper hindsight reasoning ". Examiner contends that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding Appellant's arguments for Claim 5, Appellant argues in the Appeal Brief, Page 14, last paragraph, that "reference number 139 in Minowa '161 designates an 'inner cover' (not a slot)..." and cites a definition of a slot from Webster's Ninth New Collegiate Dictionary as "a narrow opening or groove... a narrow passage or enclosure" in Page 15, 2nd paragraph (emphasis placed in underline by the Examiner). As seen in the Examiner's rejection, Examiner referred to the claimed slot as within element 139 in Fig. 8 and 10 of Minowa '161, and as seen in Fig. 10, element 139 provides an enclosure for securing an inserted document. Thus, by the Appellant's own cited definition of a "slot", Examiner submits that Minowa '161 teaches a slot for accommodating the inserted document since the inner cover 139 provides an enclosure for the inserted document.

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Appellant also argues for Claim 5 in the Appeal Brief, Page 16, 1st paragraph, that the "alleged motivation embodies clear hindsight reasoning, as the reason advanced by the Examiner is based on a perceived beneficial, after-the-fact result". Examiner asserts that both references are directed towards vertically-oriented scanners and thus, incorporating the features of one device into another would have been obvious to one of ordinary skill in the art. Further, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Stephen Yam 

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Stephen Yam 

Georgia Epps

Drew Dunn 


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